

## **REMARKS**

Claims 37, 39, 47 and 51-53 remain in the application for consideration. In view of the following remarks, Applicant respectfully requests that the application be forwarded onto issuance.

### **§ 103 Rejections**

Claims 37, 39, 47 and 51-53 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,600,496 to Wagner et al. (hereinafter "Wagner") in view of U.S. Patent No. 5,850,249 to Massetti et al. (hereinafter "Massetti") and in further view of U.S. Patent No. 6,177,931 to Alexander et al. (hereinafter "Alexander") and still further in view of U.S. Patent No. 6,421,728 to Mohammed et al. (hereinafter "Mohammed").

### **The Claims**

**Claim 37** recites an apparatus comprising

- an interactive television device configured to display a television program, wherein the interactive television device displays an interactive television mode indicator if the displayed television program supports an interactive television mode, the interactive television device activates the interactive television mode in response to a request from a viewer of the television program to activate the interactive television mode, and the interactive television device updates a channel status list to indicate that the television program is being viewed in the interactive television mode, and wherein the interactive television device includes at least one video tuner to tune the displayed television program and a plurality of data tuners to maintain an interactive state of multiple channels.

1 In making out the rejection of this claim, the Office argues that its subject  
2 matter is obvious over Wagner in view of Massetti and further in view of  
3 Alexander and still further in view of Mohammed. Applicant respectfully  
4 disagrees and submits that the Office has failed to establish a *prima facie* case of  
5 obviousness with respect to this claim for at least the reason that the Office has  
6 failed to provide a proper motivation to combine the cited references.

7 First, the Office's rationale in including Massetti in its § 103 argument is  
8 unclear. The Office fails to specifically reference the particular features of the  
9 present claim that are purportedly taught by Massetti. The Office merely cites to  
10 several features disclosed by Massetti and concludes that Massetti "thus provid[es]  
11 information to advertisers regarding what programs and services users are  
12 watching and using." Office Action at page 3. However, nowhere does claim 37  
13 recite the feature of providing information to advertisers regarding what programs  
14 and services users are watching and using. Applicant is puzzled as to the Office's  
15 reasoning in including this reference.

16 Further, the Office has failed to provide sufficient motivation to combine  
17 Massetti with the other cited references. The Office argues the motivation of "thus  
18 providing information to advertisers regarding what programs and services users  
19 are watching and using." Office Action at page 4. However, this statement  
20 merely provides a *result* for the combination and does not provide a *motivation*.  
21 Applicant points out that the mere fact that references *can* be combined or  
22 modified does not render a resultant combination obvious unless the prior art also  
23 suggests the *desirability* of the combination. See In re Mills, 916 F.2d 680, 16  
24 USPQ2d 1430 (Fed. Cir. 1990). The Office has failed to provide any specific  
25

1 reasons why the combination of Massetti with the cited references would result in  
2 a desirable combination.

3 In reference to the Office's argument for the inclusion of Alexander in the  
4 combination of cited references, Applicant submits that the Office has again failed  
5 to provide sufficient motivation to combine these references. The Office states the  
6 motivation as allowing the combined references to "analyze user characteristics to  
7 provide targeted advertising." Office Action at page 4. However, this statement  
8 merely provides a *result* for the combination and does not provide a *motivation*.  
9 As explained above, the Office bears the burden in a § 103 rejection of explaining  
10 why the stated combination is *desirable*, and thus cannot simply rely on the fact  
11 that the references *can* be combined.

12 Finally, Applicant submits that the Office has failed to provide sufficient  
13 motivation to combine Mohammed with the other cited references. The Office  
14 states that the motivation to include Mohammed in the combination of references  
15 lies in "the advantage of not taking up additional bandwidth in the cable modem  
16 channel." Office Action at page 5. Applicant submits, however, that this  
17 statement is merely a variation of an "efficiency" argument that has been deemed  
18 by the Office to be insufficient to establish a motivation to combine under § 103.  
19 See, e.g., the paper available at the following link:

20  
21 <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>  
22

23 In particular, section V of this paper discusses the "efficiency as a motivation"  
24 argument. This section explains that the motivation of efficiency is *too general*  
25 because it could cover almost any alteration contemplated of the primary

1 reference(s). Similarly, the motivation provided here of “not taking up additional  
2 bandwidth” is simply too general and could cover a myriad of alterations of the  
3 stated references. The Office has failed to provide a specific argument that  
4 explains why the combination of Mohammed with the other references is  
5 desirable.

6 Accordingly, and at least for the reasons discussed above, the Office has  
7 failed to establish a *prima facie* case of obviousness with respect to this claim.  
8 This claim is allowable.

9 **Claim 39** recites an apparatus comprising

10  
11 an interactive television device configured to display a television program,  
12 wherein the interactive television device displays an interactive television  
13 mode indicator if the displayed television program supports an interactive  
14 television mode, the interactive television device activates the interactive  
15 television mode in response to a request from a viewer of the television  
16 program to activate the interactive television mode, and the interactive  
17 television device updates a channel status list to indicate that the television  
18 program is being viewed in the interactive television mode, and wherein the  
19 interactive television device includes a video tuner to tune a current  
20 television program and a plurality of data tuners, wherein each of the  
21 plurality of data tuners maintains an interactive state of a television  
22 program previously activated in the interactive television mode.  
23

24 In making out the rejection of this claim, the Office simply relies on the  
25 arguments presented for claim 37. Accordingly, and as explained above,  
Applicant again submits that the Office has failed to provide a proper motivation  
to combine the cited references and has, for at least this reason, failed to establish  
a *prima facie* case of obviousness with respect to this claim.

Further, the Office’s *prima facie* case of obviousness with respect to this  
claim fails for the additional reason that the cited references fail to disclose or

1 suggest all of this claim's recited features. Specifically, none of the cited  
2 references disclose or suggest the features of a plurality of data tuners, wherein  
3 each of the plurality of data tuners maintains an interactive state of a television  
4 program previously activated in the interactive television mode. The Office's  
5 arguments with respect to these features are unclear at best. Nonetheless, it  
6 appears that the Office is relying on Mohammed for the teaching of these  
7 particular features. A careful review of Mohammed, however, reveals that  
8 nowhere does this reference disclose or suggest these features of the present claim.  
9 Specifically, Mohammed teaches a client that has two separate modems, one for  
10 receiving downstream data and one for sending upstream data. See Mohammed at  
11 column 5, lines 32-44. Nowhere does Mohammed disclose or suggest that its  
12 modems have the ability to maintain an interactive state of a *television program*  
13 previously activated in an interactive television mode. This feature is simply  
14 missing from Mohammed, and indeed from all of the other cited references.

15 Accordingly, and for at least the reasons discussed above, the Office has  
16 failed to establish a *prima facie* case of obviousness with respect to this claim.  
17 This claim is allowable.

18 **Claim 47** recites one or more computer-readable media having stored  
19 thereon a computer program that, when executed by one or more processors,  
20 causes the one or more processors to:

- 21 • display a video program;
- 22 • display an interactive video mode indicator if the displayed video
- 23 program supports an interactive video mode, wherein a video tuner
- 24 tunes the displayed video program, and wherein separate data tuning
- 25 devices maintain an interactive video status for each video channel;

- activate the interactive video mode in response to a request from a viewer of the video program to activate the interactive video mode; and
- update a channel status list to indicate that the video program is being viewed in the interactive video mode.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Wagner in view of Massetti and further in view of Alexander and still further in view of Mohammed. For at least the reasons discussed below, Applicant submits that the Office has failed to establish a *prima facie* case of obviousness with respect to the present claim.

First, the particular motivations provided by the Office to combine the cited references are identical to those provided for the previous claims discussed above. Accordingly, Applicant reiterates that the motivations provided by Office are insufficient under the § 103 standard and thus fail to establish a *prima facie* case of obviousness.

Further, Applicant submits that the cited references fail to disclose or suggest all of the features recited by the present claim. Specifically, the cited references fail to disclose or suggest the feature of separate data tuning devices that maintain an interactive video status for each video channel. The Office's argument with respect to this feature is unclear at best. Nevertheless, it appears that the Office is relying on Mohammed as teaching this particular feature of the present claim. As explained above, however, Mohammed teaches a client that has two separate *modems*, one for receiving *downstream data* and one for sending *upstream data*. Nowhere does Mohammed or indeed any of the other cited references disclose or suggest separate *data tuning devices* that maintain the

1 interactive status for *each video channel*. This feature is simply missing from the  
2 cited references.

3 Based at least on the arguments presented above, the Office has failed to  
4 establish a *prima facie* case of obviousness with respect to this claim. This claim  
5 is allowable.

6 **Claim 51** recites an apparatus comprising

7  
8 an interactive television device configured to display a television program,  
9 wherein the interactive television device displays an interactive television  
10 mode indicator if the displayed television program supports an interactive  
11 television mode, the interactive television device activates the interactive  
12 television mode in response to a request from a viewer of the television  
13 program to activate the interactive television mode, wherein the interactive  
14 television device updates a channel status list to indicate that the television  
15 program is being viewed in the interactive television mode, and wherein the  
16 interactive television device includes a video tuner to tune the displayed  
17 television program, and further includes a plurality of tuning devices to  
18 maintain an interactive television status for each channel.

19 In rejecting this claim, the Office relies on the same arguments presented  
20 for claim 37. Accordingly, and as discussed above, Applicant reiterates that the  
21 Office has failed to provide sufficient motivation to combine the cited references  
22 and has, for at least this reason, failed to establish a *prima facie* case of  
23 obviousness with respect to this claim.

24 Further, Applicant submits that the Office has failed to establish a *prima*  
25 *facie* case of obviousness for the additional reason that the cited references fail to  
teach all of this claims recited features. Specifically, the cited references fail to  
disclose or suggest the feature of a plurality of tuning devices that maintain an  
interactive television status for each channel. From the Office's argument (which

1 is difficult to decipher), it appears that the Office is relying on Mohammed to  
2 teach this feature. However, as explained above, Mohammed merely teaches a  
3 client that has two separate *modems*, one for receiving *downstream data* and one  
4 for sending *upstream data*. Nowhere does Mohammed or any of the other cited  
5 references disclose or suggest a *plurality of tuning devices* that maintain an  
6 *interactive television status* for each channel.

7 Accordingly, and at least for the reasons discussed above, the Office has  
8 failed to establish a *prima facie* case of obviousness with respect to this claim.  
9 This claim is allowable.

10 **Claim 52** recites an apparatus comprising

11  
12 an interactive television device configured to display a television program,  
13 wherein the interactive television device displays an interactive television  
14 mode indicator if the displayed television program supports an interactive  
15 television mode, the interactive television device activates the interactive  
16 television mode in response to a request from a viewer of the television  
17 program to activate the interactive television mode, wherein the interactive  
18 television device updates a channel status list to indicate that the television  
19 program is being viewed in the interactive television mode, and wherein the  
20 interactive television device includes a video tuner to tune a current  
21 television program and a plurality of data tuners, wherein each of the  
22 plurality of data tuners maintains an interactive state of a television  
23 program previously activated in the interactive television mode.  
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20 In rejecting this claim, the Office relies on the same arguments presented in  
21 its rejection of claim 37. Accordingly, and as discussed above, Applicant  
22 reiterates that the Office has failed to provide sufficient motivation to combine the  
23 cited references and has, for at least this reason, failed to establish a *prima facie*  
24 case of obviousness with respect to this claim.  
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1 Further, Applicant submits that the Office has failed to establish a *prima*  
2 *facie* case of obviousness for the additional reason that the cited references fail to  
3 teach all of this claims recited features. Specifically, the cited references fail to  
4 disclose or suggest the feature of a plurality of data tuners that each maintains an  
5 interactive state of a television program previously activated in an interactive  
6 television mode. From the Office's arguments it appears that the Office is relying  
7 on Mohammed to teach this feature. However, as explained above, Mohammed  
8 merely teaches a client that has two separate *modems*, one for receiving  
9 *downstream data* and one for sending *upstream data*. Nowhere does Mohammed  
10 or any of the other cited references disclose or suggest a plurality of *data tuners*  
11 that *each* maintains an interactive state of a *television program* previously  
12 activated in an interactive television mode. These features are simply missing  
13 from the cited references.

14 Accordingly, and at least for the reasons discussed above, the Office has  
15 failed to establish a *prima facie* case of obviousness with respect to this claim.  
16 This claim is allowable.

17 **Claim 53** recites one or more computer-readable media having stored  
18 thereon a computer program that, when executed by one or more processors,  
19 causes the one or more processors to:

- 20
- 21 • display a video program;
- 22 • display an interactive video mode indicator if the displayed video  
program supports an interactive video mode;
- 23 • activate the interactive video mode in response to a request from a  
viewer of the video program to activate the interactive video mode;  
and
- 24 • update a channel status list to indicate that the video program is  
25 being viewed in the interactive video mode;

- wherein a video tuner tunes the displayed video program, and wherein a separate data tuning device maintains an interactive video status for each video channel.

In rejecting this claim, the Office relies on the same arguments presented for claim 47. Accordingly, and based on the discussion of claim 47, Applicant submits that the Office has failed to establish a *prima facie* case of obviousness for at least the reason that the Office has failed to provide sufficient motivation to combine the cited references.


Further, Applicant submits that the Office's *prima facie* case of obviousness fails for the additional reason that the cited references fail to teach all of this claims recited features. Specifically, the cited references neither disclose nor suggest the feature of a separate data tuning device that maintains an interactive video status for each video channel. From the Office's argument it appears that the Office is relying on Mohammed to teach this feature. However, as explained above, Mohammed merely teaches a client that has two separate *modems*, one for receiving *downstream data* and one for sending *upstream data*. Nowhere do Mohammed or any of the other cited references disclose or suggest a *separate data tuning device* that maintains an interactive *video* status for *each video channel*. This feature is simply missing from the cited references.

Accordingly, and at least for the reasons discussed above, the Office has failed to establish a *prima facie* case of obviousness with respect to this claim. This claim is allowable.

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Respectfully Submitted,

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